



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,089	10/25/2006	Rainer Wolber	P29248	9023
7055 7590 10/18/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER NIEBAUER, RONALD T	
			ART UNIT 1654	PAPER NUMBER
			NOTIFICATION DATE 10/18/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary

Application No.

10/571,089

Applicant(s)

WOLBER ET AL.

Examiner

Ronald T. Niebauer

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 29-81 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1654

DETAILED ACTION

Election/Restrictions

Claims 1-28 have been cancelled. Claims 29-81 are under consideration.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Note: Due to the large quantity of compounds recited in claim 52 the compounds will be identified by the terminal functional group. For example -alanine compounds refers compounds such as N-[(2E)-1,2-dimethyl-3-(2,6,6-trimethylcyclohex-1-en-1-yl)-prop-2-en-1-yl- idene]-L-alanine; -but-3-ene-2-one refers to compounds such as (3E)-3-methyl-4-(2,6,6-trimethylcyclohex-1-en-1-yl)but-3-ene-2-one.

Group 1, claim(s) 52 in part, drawn to a composition with -but-3-ene-2-one compounds.

Group 2, claim(s) 52 in part, drawn to a composition with -L-alanine compounds.

Group 3, claim(s) 52 in part, drawn to a composition with -octa-3,5,7-trien-2-one compounds.

Group 4, claim(s) 52 in part, drawn to a composition with -but-3-en-2-one compounds.

Group 5, claim(s) 52 in part, drawn to a composition with -but-3-en-2-one oxime compounds.

Group 6, claim(s) 52 in part, drawn to a composition with -octa-3,5-dien-2-one compounds.

Group 7, claim(s) 52 in part, drawn to a composition with -ethanol compounds.

Group 8, claim(s) 52 in part, drawn to a composition with -octa-3,5-dien-2-one oxime compounds.

Group 9, claim(s) 52 in part, drawn to a composition with -ethyl acetate compounds.

Group 10, claim(s) 52 in part, drawn to a composition with -D-glucopyranoside compounds.

Group 11, claim(s) 52 in part, drawn to a composition with -L-alaninate compounds.

Group 12, claim(s) 52 in part, drawn to a composition with -octa-3,5,7-trien-2-one compounds.

Group 13, claim(s) 52 in part, drawn to a composition with -octa-3,5,7-trien-2-one oxime compounds.

Group 14, claim(s) 52 in part, drawn to a composition with -penta-2,4-dienal compounds.

Group 15, claim(s) 52 in part, drawn to a composition with -undeca-2,4,6,8,10-pentaenal compounds.

Group 16, claim(s) 52 in part, drawn to a composition with -pent-4-enal compounds.

Art Unit: 1654

Group 17, claim(s) 52 in part, drawn to a composition with –dihydroretinal compounds.

Group 18, claim(s) 52 in part, drawn to a composition with –octahydroretinal compounds.

Group 19, claim(s) 52 in part, drawn to a composition with –octa-5,7-dien-2-one compounds.

Group 20, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 1.

Group 21, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 2.

Group 22, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 3.

Group 23, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 4.

Group 24, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 5.

Group 25, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 6.

Group 26, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 7.

Group 27, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 8.

Group 28, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 9.

Group 29, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 10.

Group 30, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 11.

Group 31, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 12.

Group 32, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 13.

Group 33, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 14.

Group 34, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 15.

Group 35, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 16.

Group 36, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 17.

Group 37, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 18.

Group 38, claim(s) 74 in part, 79-80 drawn to a method of applying to hair a composition of group 19.

Art Unit: 1654

Group 39, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 1.

Group 40, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 2.

Group 41, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 3.

Group 42, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 4.

Group 43, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 5.

Group 44, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 6.

Group 45, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 7.

Group 46, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 8.

Group 47, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 9.

Group 48, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 10.

Group 49, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 11.

Group 50, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 12.

Group 51, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 13.

Group 52, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 14.

Group 53, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 15.

Group 54, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 16.

Group 55, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 17.

Group 56, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 18.

Group 57, claim(s) 74 in part, 72-73,75-78 drawn to a method of applying to skin a composition of group 19.

Claims 29-51,53-71,81 link(s) inventions of Group 1-19. The restriction requirement between the linked inventions is **subject to** the nonallowance of the linking claim(s), claims 29-

Art Unit: 1654

51,53-71,81. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

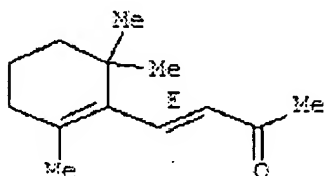
Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

It is noted that this is a group restriction, not an election of species. The election of species appears below.

The inventions listed as Groups 1-57 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: PCT Rule 13.2 defines "special technical features" as "those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." Claim 29 is drawn to a composition of matter comprising a particular compound. Heltoivics et al. (WO 02/36088 as cited in search report

Art Unit: 1654

submitted with application) teach a fragrance oil for administration to the skin (abstract) that includes ionone beta (page 35 composition VII or VIII). Ionone beta (see attached registry structural information) structure is as follows:



Compared to formula A of the current invention R1, R2, and R5 are methyl, R3 if formulae I, R6 is H, R6prime is H, R4 is carbonyl oxygen, n is 1. Therefore ionone beta meets the structural limitations of formula A. Thus the technical features are not a contribution over the prior art and the claims lack unity.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

Art Unit: 1654

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Election of Species

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

For whichever group is elected, the species are as follows:

Compound: a compound as recited generally in claim 29. Applicant should elect a single species such that all variable groups are uniquely defined.

Other ingredients: if any, claims 57-69 recite a multitude of possible other ingredients. Applicant is to identify which specific ingredients, if any, are present in the elected invention. It is noted that one single composition should be identified. For example, applicant could specify the first recited compound of claim 52 ((3E)-3-methyl-4-(2,6,6-trimethylcyclohex-1-en-1-yl)but-3-ene-2-one) along with no other ingredients. As another example, applicant could specify the first recited compound of claim 52 ((3E)-3-methyl-4-(2,6,6-trimethylcyclohex-1-en-1-yl)but-3-ene-2-one) along with glycerol (as recited in claim 63) and green tea extracts (as recited in claim 66).

Applicant is required, in reply to this action, to elect a **single species** to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply **must also identify the claims readable on the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Art Unit: 1654

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Claim 29 is generic to all the species.

The following claim(s) are generic: claim 29.

There is an examination and search burden for the species due to their mutually exclusive characteristics. Each of the species are structurally distinct and one of skill in the art would not recognize that every alternative would behave in the same way. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Art Unit: 1654

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald T. Niebauer whose telephone number is 571-270-3059. The examiner can normally be reached on Monday-Thursday, 7:30am-5:00pm, alt. Friday, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

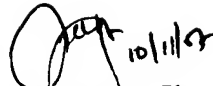
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/571,089

Page 11

Art Unit: 1654


rtn

 10/11/09
ANISH GUPTA
PRIMARY EXAMINER